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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,156	06/21/2000	Jeff Young	2230	6933

7590 10/07/2004

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EXAMINER	
NGUYEN BA, HOANG VU A	
ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/599,156	YOUNG ET AL.
	Examiner	Art Unit
	Hoang-Vu A Nguyen-Ba	2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 June 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed May 17, 2004.

2. Claims 1-51 remain pending.

Response to Amendment

3. Per Applicant's request, claims 1, 16, 27 and 42 have been amended.

Response to Arguments

4. Applicant's arguments filed concurrently with the above-mentioned amendment have been fully considered but they are not persuasive. Following is the examiner's response to Applicant's arguments.

a. With respect to claim 1 being rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,860,012 to Luu:

Applicant's arguments:

> ... As discussed in the interview with the Examiner (Ken Gross) on March 30, 2004, applicants respectfully submit that the cited section of Luu does not teach or suggest the elements recited in amended claim 1, including the concept of a transmitted installation service that installs software independent of any installation software previously installed on the client machine...
>
> ... In contrast, the method taught by Luu requires a program already present on Luu's machine that installs the software. More particularly, the Luu installation package 303 of FIG. 3 and 503 of FIG. 5 is a text file that comprises data to be operated upon (or carried out) by Luu's special installation program (302 of FIG. 3 and 601 of FIG. 6) that is already stored on the user workstation 202. The installation package is merely text data interpreted by this already-present "special installer program" of Luu; and, further, is not even a service as recited in claim 1...

Examiner's response:

First, the examiner notes that none of the portions (e.g., package 303 of Fig. 3; 503 of Fig. 5; 302 of Fig. 3; 601 of Fig. 6) cited in the above excerpt of applicant's remarks refer to the portions (e.g., 1:60-66; 2:2-6; 5:10-15; 7:18-20; Appendix A) cited in support of the rejection of the limitations of claim 1 by the former examiner. Applicant's arguments are therefore moot.

Second, the examiner submits that the three limitations of claim 1, including the new limitation added by amendment (i.e., "the executing independent of any installation program previously installed on the client machine") are found to be anticipated by Luu as follows:

initiating a connection at a server to the client machine (1:60-66 in the previous Office action – OA; furthermore, for additional evidence that this limitation is anticipated by Luu, the examiner directs Applicant's attention to 6:46-48 which shows that Luu discloses that system clock can be used to initiate a connection at a server to a client machine);

transmitting an installation service (note that the limitation *installation service* is broadly and reasonably interpreted to mean the **installation package – IP –** of Luu that includes the IPACK format file and the application software to be installed – 5:16-18; also note that the IP is being stored on a system server – 6:32-33) *that install software, the installation service transmitted from the server to the client machine based on the connection initiated by the server* (2:2-6 in the previous OA; see also 6:32-33); and

executing the installation service on the client machine, the executing independent of any installation program previously installed on the client machine (2:2-6; note that the instant claim recites a method for *executing the installation service* without explicitly specifying a task carrier; since the execution of Luu's IP, which is a set of commands

that modify system files and perform other functions necessary to the installation of the application software, is performed independently of any installation program installed on the client machine, the examiner found that the instant limitation is anticipated by Luu).

Therefore, the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Luu is still proper and maintained.

The examiner however notes that several aspects of applicant's invention, such as *discovering the client machine* (claim 2), *evaluating a discovery information against a set of rules* (claims 3 and 4), *initiating a connection to the client machine includes dequeuing and processing a configuration request* (claim 12) and *executing the installation service includes running a bootstrap service to connect the client machine to another server, and transmitting additional software from the other server for installing on the client machine* (claim 13) have not been claimed in claim 1. The incorporation of these steps taken in combination in claim 1 would clearly and particularly point out the subject matter of the invention and distinguish over Luu taken in combination with the other art of record.

b. With respect to claims 2-15 being rejected under 35 U.S.C. § 103(a) as being unpatentable over Luu in view of May:

Applicant's arguments:

> For example, claim 2 recites that initiating a connection includes discovering the client machine, e.g., determining the location or other identification of client machines on the network. Applicants find no description in May of discovering a client machine. The Office Action concedes that May does not explicitly teach discovering the client machine. Instead, the allegation appears to be that May's MIS may have location information for each remote computer. However, in contrast to the claims, such location information is not taught as being inherently or expressly obtained by any discovery mechanism whatsoever in the prior art; discovery comes from applicants' teachings.

Examiner's response:

While May does not explicitly teach discovering a client machine, May does teach location information of each remote computer. The step of determining the location of remote client is thus considered to be obvious in light of May's teaching of a location information because it would be inconceivable in a network for servers to remotely install software on clients without knowing where clients are. And May's teaching of location information helps to make this step possible.

c. With respect to claim 13, the examiner agrees with applicant that Luu, taken individually or in combination, does not appear to teach or suggest features recited in this claim.

d. With respect to claim 16, Applicant submits that claim 16, as amended, is patentable over the prior art of record. In response to this argument, the examiner directs Applicant's attention to 2:12-13 which shows that Luu does teach that a personality file may be defined which allows for custom tailoring (e.g., *installing part of the management software*) of the installation on a user's workstation.

e. With respect to claims 17-26, Applicant submits that these claims by similar analysis to claims 16 and 1-15 are patentable. In response to this argument, the examiner notes that the rationale for rejecting claims 1-15 and 16 also applies to claims 17-26.

f. With respect to claims 28-41:

Applicant's arguments:

> In contrast to the recitation of claim 27 that executing the installation service is independent of any installation program previously installed on the client machine, Luu is directed to a system where a previously installed installation program on Luu's machine installs the software, not the Luu installation package, For at least this reason, applicants submit that claim 27, and dependent claims 28-41, by similar analysis, are patentable over the prior art of record. Applicants submit that claims

28-41 are also allowable for the additional patentable elements included in these claims.

Examiner's response:

The examiner notes that since the execution of Luu's IP, which is a set of commands that modify system files and perform other functions necessary to the installation of the application software, is performed independently of any installation program installed on the client machine, the examiner found that the instant limitation is anticipated by Luu).

Claims 28-41, which incorporate subject matter of claim 27, are also rejected for the same reasons.

g. With respect to claim 42-51: since Applicant's arguments are similar to those of claims 27-41 previously discussed, the same rationale for rejection of these claims are also applied these claims.

In view of the foregoing discussion, the examiner maintains that the rejections of claims 1-51 as being unpatentable over the prior art of record are proper. See previous Office action for detailed discussion of the rejection of theses claims.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (703) 305-0103. The examiner can normally be reached on Tuesday-Friday, 6:00 to 16:15.

After October 25, 2004, the Examiner can be reached at (571) 272-3701 and the Examiner's supervisor at (571) 272-

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ANTONY NGUYEN-BA
PRIMARY EXAMINER

Art Unit 2122

October 3, 2004